

<h1 style="margin: 0;">TRANSMITTAL FORM</h1> <p style="margin: 5px 0;">(to be used for all correspondence after initial filing)</p>		Application Number	09/878,401-Conf. #2192
		Filing Date	June 12, 2001
		First Named Inventor	Jae Yong PARK
		Art Unit	2674
		Examiner Name	J. T. Nguyen
Total Number of Pages in This Submission	9	Attorney Docket Number	2658-0268P

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <div style="margin-left: 40px;"><input type="checkbox"/> Landscape Table on CD</div>	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<div style="border: 1px solid black; width: 150px; height: 20px; margin: 0 auto; text-align: center;">Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	BIRCH, STEWART, KOLASCH & BIRCH, LLP		
Signature			
Printed name	Esther H. Chong		
Date	August 28, 2006	Reg. No.	40,953



AF
JW



PATENT
2658-0268P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant:	PARK, Jae Yong	Conf. No.:	2192
Appl. No.:	09/878,401	Group:	2674
Filed:	June 12, 2001	Examiner:	J. T. Nguyen
For:	ELECTRO LUMINESCENCE DISPLAY		

REPLY BRIEF ON APPEAL UNDER 37 C.F.R. § 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Due: August 28, 2006

Sir:

Appellant hereby replies to the arguments presented by the Examiner in the Examiner's Answer dated June 28, 2006, the reply being in support of Appellant's appeal from the decision in the final Office Action dated June 22, 2005 finally rejecting claims 1-11.

Initially, Appellant thanks the Examiner for reviewing the Information Disclosure Statement (IDS) filed on July 24, 2006 and for indicating to Appellant's below named representative, on August 24, 2006 that the newly cited reference in that IDS would not be used to reopen prosecution or to reject Appellant's claims on appeal, and that an initialed copy of the form listing that reference would be provided to Appellant in due course.

The Examiner's Answer contains, on page 5 thereof, a response to Appellant's arguments presented in the Appeal Brief with respect to the rejection of claims 1-11 under 35 USC §103(a) as being unpatentable over Kawada et al. ("Kawada"). Appellant responds to the Examiner's response, as follows:

Appellant argued, in the first paragraph on page 12 of the Appeal Brief, that, "[B]ecause Kawada does not have the recited planar state and the Office Action fails to present any objective factual evidence that would motivate a skilled worker to modify Kawada to achieve the recited planar state, Appellant can only conclude that the rejection is based on impermissible speculation or impermissible hindsight reconstruction of the claimed invention based solely on Applicant's disclosure."

The Examiner's response, found on page 5 of the Examiner's Answer, states, for the very first time, that "[T]he planar state is *generally flat*. Kawada teaches the electroluminescence device is a flat display panel; accordingly, the tape carrier packages connecting the driving circuit boards and the electroluminescence panel are generally flat or in planar state."

This new argument/position is completely inconsistent with the Examiner's previous position on this issue in the final rejection. The Examiner clearly, unmistakably and unequivocally admitted on page 2 of the final rejection of claims 1-11 that "Kawada differs from claims 1 and 11 in that he

does not specifically teach the tape carrier packages connecting the driving circuit boards and the electro-luminescence panel in a planar state.”

The Examiner cannot have it both ways, i.e., by basing the final rejection on a clear, unmistakable and unequivocal admission that Kawada’s device does not disclose the “planar state” feature and arguing that it would be obvious to modify Kawada to provide such a feature, and now arguing that Kawada does disclose the claimed “planar state” feature. This is a fundamental change in the rejection, resulting in a clear inconsistency between the final rejection and this new ground of rejection.

Furthermore, the Examiner adds yet another completely different basis for the alleged obviousness rejection arguing that it would be obvious to make the heat sink contiguous with the panel, an argument that was never presented in the final rejection. All that the final rejection said in terms of Kawada’s heat sink, found on page 3 of the final rejection, is that “it would have been obvious to minimize the size of the heat sink in order to provide a display that is capable of being made having a small thickness.” Nothing is stated in the final rejection about making Kawada’s heat sink contiguous with Kawada’s panel. Thus, this is a completely different basis for the rejection than was presented in the final rejection.

To address the “planar state” feature, Appellant respectfully submits that Kawada’s Fig. 4c embodiment, on which the rejection is based, does not

disclose or suggest that Kawada's TAB lead 21b', IC chip 21, TAB lead 21a', heat sink block 26 and PCB 23 are in the same plane as the electroluminescence panel made up of substrates 12 and 15 and thus, Kawada does not disclose or suggest that the tape carrier packages connecting the driving circuit boards and the electroluminescence are in a planar state, i.e., in a plane substantially parallel to the plane in which the panel lies.

Appellant's understanding of what it means by being in a planar state is also supported by Appellant's claim 8, which recites that a substantial portion of each of the tape carrier packages is in a common plane with the driving circuit boards. This feature is illustrated, for example, in Appellant's Fig. 9, but is neither disclosed nor suggested by Kawada.

To address the newly presented argument regarding significantly redesigning Kawada so that its heat sink is relocated to be contiguous with the electroluminescence panel, Appellant respectfully notes that the Office Action completely fails to present any objective factual evidence of proper motivation for one of ordinary skill in the art to make such a relocation of Kawada's heat sink to achieve a planar state device. Instead of providing objective factual evidence, as required by case law including the decisions in In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), and In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999), the Office Action relies on an improper *per se* rule of unpatentability by stating that the

relocation of a well known element is normally not directed to patentable subject matter and, in this case, would not alter the operation or function of the device, citing a pre-1952 Patent Act case, *In re Japikse*, 86 USPQ 70 (CCPA 1970).

Appellant respectfully disagrees with this statement of what happened in the “Japikse” case. Japikse claimed a hydraulic power press. Claim 3 of Japikse allegedly read on the Cannon reference except for the feature, “means disposed in alignment with said opening for contact by said depending means to start the pressing operation of said hydraulic press.” The Board held that there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified. The Court found no error in that holding of the Board.

In the first place, Appellant respectfully submits that it is completely improper to base a rejection on the broad, general principle quoted above, which is not clear and particular objective factual evidence which would motivate one of ordinary skill in the art to modify Kawada to redesign and reconstruct Kawada to provide a substantially planar device. See, in this regard, the aforementioned case law including, “*In re Lee*” and “*In re Dembiczak*.” Moreover, this approach does not address the invention as a whole, as required by the decision in the previously cited “*Graham v. John Deere*” case. Evidence of this is in the language found in this case, which is

eschewed by subsequent case law, i.e., “there is no invention in.” That is not the standard for evaluating obviousness of an invention under the subsequently enacted 1952 Patent Act.

Relying on such a statement flies in the face of the principles set down by “*Graham v. John Deere*,” and “*In re Lee*” and “*In re Dembiczak*,” and makes this rejection fundamentally improper.

Moreover, the reliance on the stated holding in this pre-1952 Patent Act case provides no objective evidence of the desire of one of ordinary skill in the art to redesign the fundamental structure of Kawada in such a counter-intuitive manner, i.e., in a manner that Kawada never imagined to provide improved results.

The Office Action fails to explain how this proposed fundamental redesign of Kawada, which deals with the operational aspects of Kawada’s device to the extent that it permits one to make a conventional ELD having a small dimension, which Appellant indicates in its disclosure is a desirable feature in such devices – see page 5 of Appellant’s specification, for example, relates to locating a power switch for a hydraulic press, as was the issue presented in Japikse.

Furthermore, mere citation of catchphrases such as “this is merely a rearrangement of parts” or “would have involved a mere change in relocate of a component” – see page 5 of the Examiner’s Answer, or of particular case law

decisions, or a section of the Manual of Patent Examining Procedure (MPEP) that cites the "Japikse" decision as a basis for rejecting claims under 35 USC § 103 is improper, as it sidesteps the fact-intensive inquiry mandated by section 103. In other words, there are not "merely a rearrangement of parts" obviousness rejections or merely "MPEP 2144.04" obviousness rejections, but rather only section 103 obviousness rejections. This method of analysis is founded on legal error because it substitutes supposed *per se* rules for the particularized inquiry required by section 103, and necessarily produces erroneous results.

As stated in In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), the use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim

limitations. The court held that its precedents do not establish any *per se* rules of obviousness.

A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Accordingly, the rejection of claims 1-11 as unpatentable over Kawada is improper and should be withdrawn.

Reconsideration and reversal of this final rejection are respectfully requested.

Dated: August 28, 2006

Respectfully submitted,

By Esther Chong
Esther H. Chong
Registration No. 40953

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747 Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

EHC/RJW:mmi

